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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATEL, HEMANT SHANTILAL

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,760	ADAMCZYK ET AL.	
	Examiner	Art Unit	
	Hemant Patel	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant Response dated June 7, 2006 to an Office Action dated March 7, 2006 is entered. Claims 21-40 are pending in this application.

Response to Amendment

2. Applicant's arguments with respect to claims 21-40 have been considered but are moot in view of the new ground(s) of rejection. The rejections are necessitated due to claim amendments.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 21-27 are rejected on the ground of nonstatutory double patenting over claims 1-5 of U. S. Patent No. 6,650,740 B1 (hereinafter referred to as Patent '740) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims 21-27 of the instant application recite limitations similar to that recited in claims 1-5 of Parent '740. The claim 21 of the instant application has added limitation of "in response to an indication to disconnect the communication between the subscriber and the caller, reconnecting the subscriber with the voicemail server", but this was disclosed in Patent '740 (col. 11, ll. 46-col. 12, ll. 8). The claim 26 recitation for the use of ISUP message is disclosed in Patent '740 (col. 11, ll. 1-4; col. 12, ll. 1-2).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 28-34 are rejected on the ground of nonstatutory double patenting over claims 6-11 of U. S. Patent No. 6,650,740 B1 (hereinafter referred to as Patent '740) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims 28-34 of the instant application recite limitations similar to that recited in claims 6-11 of Parent '740. The claim 28 of the instant application has added limitation of "a reconnecting component configured to, in response to an indication to disconnect the communication between the subscriber and the caller, reconnect the subscriber with the voicemail server", but this was disclosed in Patent '740 (Fig. 3, item 52, IP; col. 11, ll. 46-col. 12, ll. 8). The claim 33 recitation for the use of ISUP message is disclosed in Patent '740 (col. 11, ll. 1-4; col. 12, ll. 1-2).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The computer readable medium by itself does not make the reply call. When a computer (processor) executes stored program instructions (logic) on the computer readable medium, it causes the computer to make the call.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 21-23, 25, 27-30, 32, 34-37, 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer (US Patent No. 6,567,507 B1).

Regarding claim 21, Shaffer teaches of a method to make a reply call to a voice mail message, comprising:

receiving a communication request from a voicemail server (col. 4, ll. 1-3), the communication request resulting from a subscriber accessing a voicemail message created by a caller via the voicemail server and further resulting from the subscriber sending a command to connect the subscriber with the caller (col. 3, ll. 38-40);

connecting a communication between the subscriber and the caller without utilization of the voicemail server (col. 4, ll. 3-7); and

in response to an indication to disconnect the communication between the subscriber and the caller, reconnecting the subscriber with the voicemail server (col. 4, ll. 7-10, 12-14).

Regarding claim 22, Shaffer teaches of a re-call protocol element from the voicemail system to the switch (col. 4, 1-7).

Regarding claim 23, Shaffer teaches of a re-call protocol element that is a remote parameter sent from the voicemail system to the switch to initiate remote operation in the switch and this element contains phone number as routing information (col. 3, ll. 52-56) and also contains call identification information (col. 3, ll. 45-46).

Regarding claim 25, Shaffer teaches of routing the communication to a directory number (col. 3, ll. 52-56, the remote device phone number is associated with the subscriber since the subscriber desires to transfer the call to that directory number) associated with the subscriber.

Regarding claim 27, Shaffer teaches of terminating of the communication at the switch (Fig. 1, item 22; switch is a network element and is intelligent to detect a call, collect digits, make routing decisions, determine destination and terminate the call to the destination).

Regarding claim 28, it recites a system substantially implementing a method as claimed in claim 21. Shaffer teaches of such a system (Fig. 1). Refer to rejection for claim 21.

Regarding claim 29, refer to rejection for claim 22 and claim 28.

Regarding claim 30, refer to rejection for claim 23 and claim 29.

Regarding claim 32, refer to rejection for claim 25 and claim 28.

Regarding claim 34, refer to rejection for claim 27 and claim 28.

Regarding claim 35, it recites computer readable medium with logics configured substantially implementing a method as claimed in claim 21. Shaffer teaches of a system with components that use computers and computer readable mediums as is well known in the art (Fig. 1). Refer to rejection for claim 21.

Regarding claim 36, refer to rejection for claim 22 and claim 35.

Regarding claim 37, refer to rejection for claim 23 and claim 36.

Regarding claim 39, refer to rejection for claim 25 and claim 35.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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12. Claim 24, 31, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer as applied to claims 22, 29, 36 above, and further in view of Ekstrom (US Patent No. 6,148,069).

Regarding claim 24, Shaffer teaches of using industry standard signaling such as S7 (i.e. SS7, col. 4, ll. 39-40). Shaffer does not specifically teach of GR-1129 that is another industry specified signaling standard.

However, in the same field of communication, Ekstrom teaches of using GR-1129 for communication among SCP, SSP and IP (col. 1, ll. 35-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer to use GR-1129 signaling standard as taught by Ekstrom in order to permit "the SSP to keep track of billing records and release the SSP-IP voice/data connection when it is no longer required while maintaining control of the original call" (Ekstrom, col. 1, ll. 41-44).

Regarding claim 31, refer to rejection for claim 24 and claim 29.

Regarding claim 38, refer to rejection for claim 24 and claim 36.

13. Claims 26, 33, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer as applied to claims 25, 32, 39 above, and further in view of Berberich (US Patent NO. 5,818,919).

Regarding claim 26, Shaffer teaches of using industry standard signaling such as S7 (i.e. SS7, col. 4, ll. 39-40). Shaffer does not specifically teach of ISUP that is another industry specified signaling standard.

However, in the same field of communication, Berberich teaches of using ISUP messages between the switch and the platform (i.e. Intelligent peripheral) (co. II. 5, II. 7-9), with ISUP parameters to provide called party number as a subscriber-specific number to terminate the call (col. 8, II. 60-64).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer to use ISUP messages with the required parameters as taught by Berberich so that "the calling party's identity is carried forward in the ISUP parameter set" (Berberich, col. 9, II. 1-2) between different switches (Berberich, Fig. 1, items 100, 160, ..., 170) in the network.

Regarding claim 33, refer to rejection for claim 26 and claim 32.

Regarding claim 40, refer to rejection for claim 26 and claim 39.

14. Claims 27, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer as applied to claims 21, 28 above, and further in view of Albers (US Patent No. 6,229,887 B1).

Regarding claim 27, Shaffer teaches of terminating of the communication at the switch (Fig. 1, item 22; switch is a network element and is intelligent to detect a call, collect digits, make routing decisions, determine destination and terminate the call to the destination).

Also, in the same field of communication, Albers teaches of using Intelligent Peripheral (IP, Intelligent Network Element), where the call is terminated (col. 17, II. 9-40).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer to terminate the call at the IP as taught by Albers so that "it requires only one dedicated link between the IP and the surveillance premises" (Albers, col. 17, ll. 28-30) "in contrast to such a dedicated link being required between the surveillance premises and a large number of central offices, if the totality of the bridging occurred in a central office" (Albers, col. 17, ll. 30-33).

Regarding claim 34, refer to rejection for claim 27 and claim 28.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

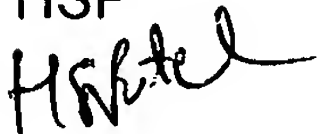
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel
Examiner
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